

NOTE: Pursuant to Fed. Cir. R. 47.6, this order is not citable as precedent. It is a public order.

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MAR 11 2005

U.S. PATENT & TRADEMARK OFFICE

# United States Court of Appeals for the Federal Circuit

05-1164

(Serial No. 08/873,974)

IN RE MICHAEL C. SCROGGIE, DAVID A. ROCHON, DAVID W. BANKER,  
and WILL GARDENSWARTZ (Real Party in Interest Catalina Marketing Corporation)

ON MOTION

## ORDER

Upon consideration of the unopposed motion of Michael C. Scroggie et al. to remand this case to the Patent and Trademark Office for further proceedings,

IT IS ORDERED THAT:

- (1) The motion is granted.
- (2) Each side shall bear its own costs.

FOR THE COURT

MAR - 9 2005

Date

Jan Horbaly  
Clerk

cc: Robert G. Crockett, Esq.  
John M. Whealan, Esq.

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MAR - 9 2005

ISSUED AS A MANDATE : \_\_\_\_\_

CERTIFIED COPY  
I HEREBY CERTIFY THIS DOCUMENT  
IS A TRUE AND CORRECT COPY  
OF THE ORIGINAL ON FILE  
UNITED STATES COURT OF APPEALS  
FOR THE FEDERAL CIRCUIT

By: \_\_\_\_\_ Date: MAR - 9 2005

FILED  
U.S. COURT OF APPEALS FOR  
THE FEDERAL CIRCUIT

MAR - 9 2005

JAN HORBALY  
CLERK

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UNITED STATES COURT OF APPEALS FOR THE FEDERAL CIRCUIT

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05-1164  
(Serial No. 08/873,974)

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IN RE MICHAEL C. SCROGGIE, DAVID A. ROCHON, DAVID W. BANKER,  
and WILL GARDENSWARTZ

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Appeal from the United States Patent and Trademark Office,  
Board of Patent Appeals and Interferences.

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**JOINT MOTION FOR REMAND**

Appellants, Michael C. Scroggie, et al. (Scroggie), and Appellee, Director of the United States Patent and Trademark Office (PTO), jointly move to remand this case to the PTO to permit further proceedings. A proposed ORDER is attached.

A review of this case reveals that the Board's decision contained a remand to the examiner on dependent claims 54, 63-69, 73-79, and 83-89 to either withdraw the rejections of those claims under 35 U.S.C. § 103 or reopen prosecution. Accordingly, this appeal is not a final decision ripe for judicial review and the parties agree that this case should be remanded back to the PTO for further action necessary. Upon remand, the PTO will conduct any further proceedings in an expedited manner.

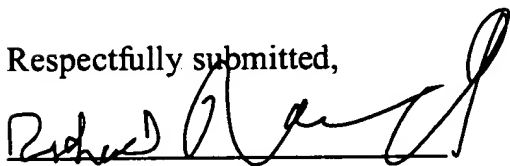
In a good faith attempt to preserve his right of appeal in view of apparent

limitation in 37 CFR § 1.304 on the time limit for filing an appeal, Scroggie filed a notice of appeal to this Court. Subsequently, undersigned counsel contacted Scroggie and informed him that because the Board's decision included a remand to the examiner to consider certain issues it was not a final decision ripe for judicial review.

The parties agreed that this case should be remanded back to the PTO for further proceedings. A remand will also avoid the needless expenditure of additional resources of this Court, the Appellants, and the PTO. See, e.g., In re Gould, 673 F.2d 1385, 1387 (CCPA 1982).


Finally, in the event that the Court chooses to deny this motion, the parties respectfully request that Scroggie's opening brief due date be extended to three weeks from the date of this Court's Order.

Respectfully submitted,



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UNITED STATES COURT OF APPEALS FOR THE FEDERAL CIRCUIT

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05-1164  
(Serial No. 08/873,974)

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IN RE MICHAEL C. SCROGGIE, DAVID A. ROCHON, DAVID W. BANKER,  
and WILL GARDENSWARTZ

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Appeal from the United States Patent and Trademark Office,  
Board of Patent Appeals and Interferences.

---

**ORDER**

Upon consideration of the JOINT MOTION FOR REMAND, it is hereby  
ordered that:

- (1) the motion is granted,
- (2) this case is remanded to the PTO for further proceedings on an expedited basis, and
- (3) each side is to bear its own costs.

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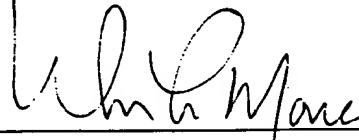
Date

cc: Richard A. Neifeld, Esq.  
Office of the Solicitor

**CERTIFICATE OF SERVICE**

I hereby certify that on February 18, 2005, I caused two copies of the foregoing JOINT MOTION FOR REMAND and proposed ORDER to be served by Federal Express addressed as follows:

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